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09/767,014	01/22/2001	Carl A. Wright	SLC-10002/29	1480

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EXAMINER	
CHARLES, DEBRA F	

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/767,014	WRIGHT, CARL A.	
	Examiner	Art Unit	
	Debra F. Charles	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 January 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-24 are rejected under 35 U.S.C. 101 because the bodies of the claims do not recite technology, i.e. computer implementation or any other technology in a non-trivial manner. *In re Toma*, 197 USPQ 852 (CCPA 1978). *Ex parte Bowman* 61 USPQ2D 1669.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) The claimed invention must produce a "useful, concrete, tangible result" (In *re Alappat*, 31USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street vs. Financial Signature Group Inc.*, 47 USPQ2d 1596' 1601-02 (Fed Cir. 1998));

AND

2) The claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. Pat. App. & Inter. 2001)).

As to the technology requirement, note MPEP 2106 IV B 2(b). Also note In *re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In *Musgrave*, 167USPQ 280 (CCPA 1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In *re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

In State Street, "in the technological arts" was never an issue. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665,1671 (BD. Pat. App. & Inter.2001)(Unpublished).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by McNamara et al.(U.S.PAT. 5818725A).

Re claim 1: McNamara et al. disclose a method for providing information related to metered usage of an electronic or digital service consumed by a user(Abstract, col. 3, lines 30-55, col. 4, lines 50-67), the method comprising the steps of receiving data relating to the metered usage of the consumed service;

rating the metered usage based on the received data(col. 2, lines 30-45, col. 6, lines 40-55);

generating information based on the rated metered usage(col. 3 line 35-col. 4, line 25); and

providing the information via a communication link to a destination location within a close time proximity to the actual consumption of the service(col. 3, lines 34-col. 4, line 67).

Re claim 2: McNamara et al. disclose further comprising a final step of providing the information to a billing application(col. 6, lines 40-55, Fig. 3B).

Re claim 3: McNamara et al. disclose further comprising a final step of displaying the information on a display device(Fig. 4).

Re claim 4: McNamara et al. disclose wherein the display device further comprises a wireless communication device(col. 5, lines 10-40).

Re claim 5: McNamara et al. disclose wherein the display device further comprises a computer(Fig. 4 and 5, col. 3, lines 45-55).

Re claim 6: McNamara et al. disclose wherein the step of generating information further comprises continuously updating the information as the units of service are consumed(Abstract, col. 2, lines 30-50,col. 3, lines 30-55, col. 4, lines 50-67).

Re claim 7: McNamara et al. disclose wherein the generated information further comprises an amount owed for consumed service such that the amount owed relates to the metered consumed units and the assessed rate(col. 3, lines 1-10, col. 6, lines 40-55).

Re claim 8: McNamara et al. disclose wherein the generated information further comprises a quote related to consumption of service(col. 3, lines 1-10, col. 6, lines 40-55).

Re claim 9: McNamara et al. disclose comprising a step of providing a message notifying a user of an event(col.4, lines 50-67, i.e. ability to send messages based on events).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 10-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNamara et al.

Re claim 10: McNamara et al. disclose a method for providing timely information related to usage of a service(Abstract, col. 3, lines 30-55, col. 4, lines 50-67), the method comprising the steps of:

providing measured units of service to one or more users(col. 2, lines 60-67);

tallying the measured units of Internet service provided to one or more users as the measured units of service are consumed by one or more users(col. 2, lines 30-45, col. 6, lines 40-55);

assessing a rate per measured unit of service consumed by one or more users as the measured units are tallied(col. 3 line 35-col. 4, line 25);

calculating a price associated with the consumed measured units of service by multiplying the tally of measured units of Internet service with the assessed rate(col. 3, lines 34-col. 4, line 67, col. 6, lines 40-55, Fig. 3B); and

forwarding, within a close time proximity to the consumption of the measured units of service by one or more users, information via a communication link to a designated location, where the information includes at least one of the tally of the measured unit of service, the assessed rated, and the calculated price(col. 3, lines 34-col. 4, line 67, col. 6, lines 40-55, Fig. 3B).

McNamara et al. does not explicitly disclose Internet. However, in col. 2, lines 60-67, McNamara et al. does disclose a network and the internet is a network. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ the internet which is a network to get the benefit of continuously metered information on usage consumption.

Re claim 11: McNamara et al. disclose further comprising an initial step of accessing, by one or more users, a connection device connected to the network(col. 4, lines 1-55, i.e. interface and interfacing).

Re claim 12: McNamara et al. disclose wherein the connection device further comprises a display device(Fig. 4).

Re claim 13: McNamara et al. disclose wherein the display device further comprises a telephone(Fig. 4 and 5, col. 3, lines 45-55, col. 4, lines 50-67).

Re claim 14: McNamara et al. disclose wherein the telephone utilizes wireless technology(col. 5, lines 10-40).

Re claim 15: McNamara et al. disclose further comprising a final step of

displaying the forwarded information on the display device accessed by the user(col. 4, lines 1-15).

Re claim 16: McNamara et al. disclose wherein the forwarded information further comprises the tally, the assessed rate, and the calculated price associated with the consumed measured units of Internet service(Abstract, col. 2, lines 30-45, col. 3, lines 30-55, col. 4, lines 50-67, col. 6, lines 40-55).

Re claim 17: McNamara et al. disclose wherein the communication link further comprises the network(col. 3, lines 34-col. 4, line 67, col. 6, lines 40-55, Fig. 3B).

Re claims 18 and 19: McNamara et al. disclose(s) the claimed invention except comprising the step of purchasing the service prior to providing measured units of service to one or more users and information further comprises data relating to the purchased Internet service not yet consumed. However, the user would have to purchase the service first in order to start the metering and billing process elsewise the provider would not agree to provide the service. And it would be obvious that the user would receive a confirmation of purchased services via a message that contains information on the service purchased before the user starts using the services. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ the strategy of purchasing the service first to get the benefit of efficient and effective service provision with real-time online displayed metering.

Re claim 20: McNamara et al. disclose wherein the forwarded information further comprising identification of one or more of the users of the services(col. 2, line 60-col. 3, line 10).

Re claim 23: McNamara et al. disclose further comprising a step of collecting the calculated price for consumed services(col. 6, lines 40-55).

Re claim 24: McNamara et al. disclose further comprising a step of discounting the calculated price according to a predetermined criterion(col. 6, lines 40-55, i.e. adjusting the price tier implies generating discount rates).

4. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNamara et al. as applied to claim 10 above, and further in view of Galich et al.(U.S.PAT. 6535591B1).

McNamara et al. disclose(s) the claimed invention except further comprising a step of estimating an expense associated with a particular service prior to consumption of the particular service. However, in Abstract, col. 10, lines 25-45 thereof, Galich et al. disclose(s) estimating the pricing of services prior to connecting the services and prior to consumer usage. It would be obvious to one of ordinary skill in the art to modify the invention of McNamara et al. based on the teachings of Galich et al. The motivation to combine these references is to provide efficient and effective estimates of services before purchase and use.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNamara et al. as applied to claim 10 above, and further in view of Gross(U.S.PAT. 6721716B1).

McNamara et al. disclose(s) the claimed invention except further comprising a step of requesting payment of the calculated price for consumed services. However, in Abstract, col. 21, lines 10-45 thereof, Gross disclose an automated payment request service. It would be obvious to one of ordinary skill in the art to modify the invention of McNamara et al. based on the teachings of Gross. The motivation to combine these references is to provide efficient and effective automated payment request.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Poinvil can be reached on (703) 305-9779. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628

Debra F. Charles

Examiner

Art Unit 3628

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